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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,237	09/24/2003	Clark Thomborson	3652-43	2051

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NIXON & VANDERHYE, PC  
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ARLINGTON, VA 22203

EXAMINER
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AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/668,237

Applicant(s)

THOMBORSON, CLARK

Examiner

Charlie C. Agwumezie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/18/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Status of Claims**

1. Claims 1-20 are cancelled. Claims 21-40 are newly added. Claims 21-40 are pending in this application per the response to office action filed on January 24, 2007.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 21-40 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 22, 29 and 36**, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically if the vendor includes the number of digital objects without an associated warning status previously submitted by the vendor, how can the warning or alert status be updated and even exceed number of digital status without associated warning status. This claim limitation is unclear and ambiguous.

### ***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 21-40**, are rejected under 35 U.S.C. 102(e) as being anticipated by Rabin et al U.S. Patent No. 7,073,197.

As per **claims 21, 28 and 35**, Rabin et al discloses a method of transacting a digital object in which a vendor offers for sale or trade the digital object to a purchaser, the method comprising the steps of:

receiving a digital object from a vendor (see figs. 1, 2 and 3; col. 3, line 60-col. 4, line 10; ...user receives and install instance of software...);

testing the digital object for the presence of an authorization code (fig. 15; col. 3, line 60-col. 4, line 10; ...supervisory program verifies authenticity...; col. 5, lines 1-20; determines whether instance was a pirated copy...);

associating a warning status with the digital object on detecting the presence of an authorization code in the digital object (figs. 5, 6; col. 7, lines 35-50; col. 8, lines 5-20 ...punitive action...);

checking a database of vendor details maintained in computer memory, the database having an entry representing the vendor, the entry including the number of

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digital objects having an associated warning status previously submitted by the vendor and alert status associated with the vendor (fig. 11; col. 12, lines 40-50 ...vendor submits copy of infringing software...);

associating an alert status with the digital object on detecting an entry in the database of vendor details representing an alert status associated with the vendor (col. 12, lines 40-50; ...computes a collection of fingerprints...);

adding one or more authorization codes to the digital object (fig. 8; ...determine continuation status...; col. 12, lines 40-50; ...computes a collection of fingerprints...);

updating the entry in the database of vendor details representing the vendor with the warning and/or alert status associated with the digital object (col. 11, lines 40-55; updating tag information ...based on outcome of the call up procedure...); and

updating the alert status associated with the vendor based at least partly on the number of digital objects having an associated warning status previously submitted by the vendor (fig. 11; col. 12, lines 40-50 ...vendor submits copy of infringing software...; col. 11, lines 40-55; updating tag information ...based on outcome of the call up procedure...; col. 19, lines 30-45; ...updates the tagged software database...).

As per **claim 22, 29, and 36**, Rabin et al disclose the method of transacting a digital object, where the entry representing the vendor includes the number of digital objects without an associated warning status previously submitted by the vendor, the method further comprising the step of updating the alert status associated with the vendor if the number of digital objects having an associated warning status exceeds the

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number of digital objects without an associated warning status (figs. 4, 6, 9 and 11; col. 12, lines 15-30 ...number of untagged compared with tagged...)

As per **claims 23, 30 and 37**, Rabin et al further discloses a method of transacting a digital object further comprising the steps of:

receiving a vendor identifier representing the vendor from which the digital object is received (col. 16, lines 55-67; ...incorporating vendor identifier...); and

adding the vendor identifier to the digital object (col. 16, lines 55-67; ...incorporating vendor identifier...; col. 36, lines 25-40; ...software vendor identifier can serve as software name...).

As per **claims 24, 31 and 38**, Rabin further discloses a method of transacting a digital object further comprising the steps of:

extracting the vendor identifier from the digital object (col. 36, lines 25-40);

comparing the extracted vendor identifier with the vendor identifier received from the vendor (col. 16, lines 55-67; compare identifier...); and

checking the digital object for an associated warning status (col. 16, lines 55-67; ...if match normal use is allowed...).

As per **claims 25, 32, and 39**, Rabin et al further discloses the method of transacting a digital object further comprising the step of removing the warning status if

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the extracted vendor identifier matches the vendor identifier received from the vendor (col. 16, lines 55-67; compare identifier...).

As per **claims 26, 33, and 40**, Rabin et al further discloses a method of transacting a digital object further comprising the step of:

associating a warning status with the digital object if the extracted vendor identifier does not match the vendor identifier received from the vendor (col. 16, lines 55-67; compare identifier...invoke punitive action if no match...).

As per **claims 27**, Rabin et al further discloses a method of transacting a digital object further comprising the steps of:

checking the database of vendor details maintained in computer memory (col. 52, line 60-col. 53, line 5; compares tag table information with tag database ); and

updating the entry in the database of vendor details representing the vendor with an alert status if the number of warning status indicators associated with the vendor exceeds a predefined threshold (col. 19, lines 30-45; ...updates the tagged software database...).

As per **claim 34**, Rabin et al further disclose a method of transaction a digital object further comprising the steps of:

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associating an alert status with the digital object on detecting an entry in the database of vendor details representing an alert status associated with the vendor (fig. 6; col. 54, lines 50-65...updates usage status and action time...); and

updating the entry in the database of vendor details representing the vendor with the alert status associated with the digital object (col. 19, lines 30-45; ...updates the tagged software database...)

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

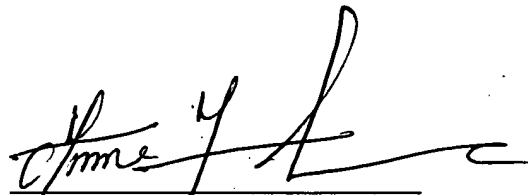
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C.L. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Andrew Fischer** can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Charlie Lion Agwumezie**  
**Patent Examiner**  
**Art Unit 3621**

**Acc**  
**April 6, 2007**



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